



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,869	10/06/2000	David Allison Bennett	PSTM0009/MRK/STM	2834

29524 7590 08/18/2009
KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710

EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

MAIL DATE	DELIVERY MODE
-----------	---------------

08/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/684,869	Applicant(s) BENNETT ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20090507</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 64-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claims 64, 69 and 74: The applicant has amended the claims to overcome the 101 rejection which causes some of the claim limitation to be unclear. The applicant has added that the computer system comprises a server and a medium which is adapted to be executed for..., it is unclear if the program on the medium is actually executed by the server computer to perform the functions. Furthermore, the applicant has changed the term “determining” into “transforming the user input into”. It is unclear how the input is transformed. The user input is package specifications, the package specifications are then used to determine a shipping rate, but the actual date itself is not actually transformed, there is no manipulation of the user input data, it is simply used for another purpose. The examiner suggests using the previous wording in the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3629

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al.(6,233,568) in view of InterShipper (Newsbytes Article, Internet Update) UPS® On Call Air Pickup (www.apps.ups.com), UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com).

7. With respect to Claim 64: Kara discloses the use of a server based shipping management computer system comprising one server computer comprising a computer readable medium having computer readable computer code (see abstract) for:

- a. Receiving information from a user such as a set of package specifications (Figure 8, Box 802) and shipping information (See Figure 8);
- b. Determining multiple shipping rates (first and second) for a first carrier (Figure 8, Boxes 807 and 808);
- c. Determining multiple shipping rates (third and fourth) for a second carrier (Figure 8, Boxes 807 and 808);

Art Unit: 3629

d. Receiving a request from a user to ship a package using one of the services by one of the carriers (See Figure 8, Column 5, lines 56-67);

e. Facilitating the delivery of the package (Column 6, lines 1-6).

8. Kara disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13). Intershipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).

9. Kara discloses receiving shipping information, however fails to disclose the receiving the shipping date from the user. UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date, the examiner considers the day the carrier picks up the package is the shipping date, since it is out of the user's hands at that time and the shipping process is started (see Page 1) UPS also discloses the shipping rates being calculated according to shipping rates, due to the fact that it calculates for Saturday Delivery. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS. Using a known technique of a user inputting the shipping date, by scheduling a pick-up time, would have been obvious to one of ordinary skill in the art. (See KSR [127 S Ct. at 1739]

Art Unit: 3629

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

10. With respect to Claims 65-67: See Figure 8, Box 807 and 808.

11. Claims 68-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara, InterShipper, UPS® On Call Air Pickup, UPS® Service Guide and FedEx® as applied to claim 64 above, and further in view of Barnett et al. (6,369,840).

12. With respect to Claims 68-79: Kara discloses the use of a server based shipping management computer system comprising one server computer comprising a computer readable medium having computer readable computer code (see abstract) for:

- f. Receiving a set of package specifications (Figure 8, Box 802) and shipping information (Figure 8);
- g. Determining multiple shipping rates (first and second) for a first carrier (Figure 8, Boxes 807 and 808);
- h. Determining multiple shipping rates (third and fourth) for a second carrier (Figure 8, Boxes 807 and 808);
- i. Receiving a request from a user to ship a package using one of the services by one of the carriers (See Figure 8, Column 5, lines 56-67);
- j. Facilitating the delivery of the package (Column 6, lines 1-6).

13. Kara disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates

Art Unit: 3629

of different services (Column 11, lines 1-13). InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).

14. Kara discloses receiving shipping information, however fails to disclose the receiving the shipping date from the user. UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date, the examiner considers the day the carrier picks up the package is the shipping date, since it is out of the user's hands at that time and the shipping process is started (see Page 1). Furthermore, UPS also discloses the shipping rates being calculated according to shipping rates, due to the fact that it calculates for Saturday Delivery. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS. Using a known technique of a user inputting the shipping date, by scheduling a pick-up time, would have been obvious to one of ordinary skill in the art. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

15. Kara discloses a display where the rates of each carrier are displayed adjacent to the selected services (See Figures 8A). However Kara does not specifically disclose the rates being calculated with respect to day and time, according to the shipping date. Both UPS® and FedEx®

Art Unit: 3629

disclose specific services where they are guaranteed delivery by a certain time in the day and disclose scheduling a pick-up. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive "urgency" services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, InterShipper, UPS® and FedEx® fail to disclose the use of a simultaneous display with shows the date and time of services Barnett discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the display of rates of Kara, Intershipper, UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

Response to Amendment

16. The affidavit under 37 CFR 1.132 filed 4/13/09 is insufficient to overcome the rejection of claims 64-79 based upon the 103 rejection as set forth in the last Office action because: First, the person making the declaration is an inventor and works for the Assignee of record.

Therefore is not considered to be an unbiased opinion and could benefit from the outcome of the case. The affidavit filed is an opinion based affidavit submitted to refute the UPS reference not using a date to calculate shipping rates. The affidavit goes through a step by step process in

Art Unit: 3629

which the applicant reviews the UPS reference and indicates that the shipping rate does not utilize a user entering in a shipping date, and therefore does not display or calculate a rate based on the entered shipping date. First the one giving the affidavit is simply giving an opinion on what the UPS reference, using the wayback machine does. However, does not argue the reference as it was applied in the rejection. Therefore even though UPS does not have one item which does both entering in a ship date and output the rates based on the entered in ship date. The UPS reference as a whole, given On-Call pick-up, the cost calculator, as well as transit times would in fact calculate this information. In the rejection the Kara reference as well as all other reference uses shipping dates and considers shipping dates when making calculations, that is why they can account for Saturday deliveries. It is just not specified that the user actually enters the ship date. UPS discloses scheduling a pick up, which would indicate that the user enters in the ship date (the ship date would be the scheduled pick up date), therefore showing that it is old and well known for a user to enter in a ship date and for the date to be considered when calculating rates.

Response to Arguments

17. Applicant's arguments filed 4/13/09 have been fully considered but they are not persuasive.

18. With respect to Applicant's Argument A, that none of the references of record disclose transforming user input into shipping rates for multiple delivery services for multiple carriers in response to receiving a set of package specifications and a shipping date and according to the shipping date: As stated above, the examiner is unclear what "transforming user input is". The

Art Unit: 3629

user inputs data, then uses it to determine a shipping rate, but the data itself is not transformed.

The applicant is arguing this argument based on the affidavit filed by the inventor. See above for specific remarks. The examiner has not indicated that UPS transforms the user input data into a shipping rate which determined according to a user entered ship date. As shown in the references calculating a rate is done using a ship date, this is seen for calculating rates such as Saturday delivery. However the claims do not specifically disclose entering in a specific ship date. UPS was used to show that a user entering in a ship date (scheduling an on call pick up), is old and well known. Therefore if combining UPS with Kara, then you would have the rate being calculated based on the ship date that is entered by the user.

19. With respect to applicants argument that none of the references disclose identifying days and times by which a package would be delivered according to a shipping date: As stated in the office action above, UPS has a service which allows the use of scheduling a pick-up of a package. When a pick up is scheduled, and the user enters in the scheduled pick-up date, then the user is submitting a shipping date. The applicant is arguing the combination of Kara and the UPS references stated that it is not obvious to one of ordinary skill in the art to combine the references because even if combined, Kara only calculates for an urgency and does not calculate for a shipping date, and asserts that there is no disclosure in either reference that teaches or suggests the combination of limitations claimed by claim 64, regarding receiving a set of package specifications and an indication of a shipping date and then in response to receiving the set of package specifications and the indication of the shipping date determining various shipping rates for various delivery services by various carriers. The examiner agrees that there is no one reference which teaches this, hence why a 103 rejection is applied. Kara discloses

Art Unit: 3629

receiving a set of parcel specifications and determining the shipping cost. UPS discloses scheduling a shipping, and discloses calculating rates based on things like shipping date (schedule a pick up), therefore the combination of references would provide claims as recited.

The applicant also appears to be arguing the combinations based on only Kara and UPS, and fails to argue the rejection as applied, i.e. with the references Intershipper and Barnett. The Applicant argued that Kara and UPS On Class would not provide the limitation of Claim 74, however the claim limitation of 74 of identifying days, would be taught by a combination of Kara, UPS, FedEx, Intershipper and Barnett.

20. With respect to Applicant's Argument C: Neither InterShipper nor Kara disclose a simultaneous display of rates: The applicant has stated a simultaneous display of rates is inferred from InterShipper, and this conclusion is unsupported. InterShipper states that the service will "return every method possible that you can use to ship your package and arrange the results in cost order and color code the results by approximate transit time". The InterShipper article may not explicitly disclose that the results are displayed on a computer screen, however InterShipper discloses all the information being given at one time. Kara discloses a computer display where multiple information is given for one package for a user to make a choice, the display is a simultaneous display of rates for each carrier, yet in order for the user to receive a display for each service, the user must click on each service and calculate. InterShipper discloses some sort of display, whether it be in terms of a computer screen, or a piece of paper, the user is provided with all the information at one time. Therefore the combination of references, Kara and InterShipper, would provide the simultaneous computer display of all the rates for all the carries for each service.

Art Unit: 3629

21. With respect to Applicant's Argument D, that none of the references of recode disclose generating a simultaneous display of delivery days for delivery of a package by multiple delivery services by multiple carriers: It is asserted that there is no disclosure in any of the references which would include the identification of "...a [particular] day on which a [particular] carrier would deliver a particular package to a particular destination according to a particular shipping date, if [the particular] carrier were to deliver said package to said destination via a [particular] delivery service.." It is agreed that there is no one reference which teaches the entire limitation, however it is the combination of all the references which provide this limitation. Kara and InterShipper disclose calculating and displaying simultaneous display of rates of each carrier of each service, the UPS and FedEx references discloses determining dates and times for shipments. Barnett discloses a calendaring system which displays things on a time and date basis. Even though the Calendaring system of Barnett is used for a different reason, Barnett discloses the calendar can be used for scheduling of services and what services or available. Therefore the determination of date and time is done by the UPS and the FedEx references, Barnett is simply displaying them in a certain fashion. It is the examiner's position that the combination of references discloses the claim limitations as recited.

22. With respect to Applicant's Argument E: the combination of limitations claimed by the rejected claims meet the KSR test for non-obvious yielding more than a separate application by the elements of the claimed limitations: The applicant is arguing these limitations using the newly added claim language of transforming user date into a shipping rate. As stated above, the user input in the claimed invention is not transformed, but rather used to form a new set of information (the shipping rate), the user input stays the same, but more data is being determined

Art Unit: 3629

or created, not that the actual input is being transformed. And even though the elements utilized in the rejection yield a separate application in some instances, there are certain instances where when combined they can be used in the same application. The UPS reference is used to show what was common in the art at the time of the invention. Entering in shipping dates and utilizing a shipping date to calculate rates is old and well known in the art. Therefore determining rates which utilize the shipping dates is old and well known. UPS shows this in not only the scheduling a pick up but there is also a transit time calculator, as well as the rate calculator. Furthermore disclose dates and times being considered when calculating rates for services, such as next day and Saturday delivery.

23. The arguments are not considered to be persuasive, and the rejections stand as stated above.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3629

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629